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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,084	01/14/2002	James Kelly O'Rourke	TAK.P0001.US	5382
7590	10/07/2004		EXAMINER	
Brouse McDowell 500 First National Tower Akron, OH 44308-1471			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/047,084 Examiner Tan Dean D. Nguyen	O'ROURKE ET AL. Art Unit 3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 March 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/22/02</u> : | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Status

Claims 1-15 are pending in this case and are treated as followed.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 3/22/02 was filed after the mailing date of the application on 1/14/02. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

2. Independent Claim 9 is objected to because of the following informalities: step (a) of claim 9 calls for "performing the method steps of independent claim 7" which is improper. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. **Claims 12-15, 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In claim 12, it's not clear the relationship of the "analysis data" in elements (a) and (b)? Are they the same or different? It's not clear how the current elements (a)-(c) are used to meet the scope of the claimed invention which is "managing the data of a business laboratory testing analysis, where the analysis is done by at least two analytical sources". There is no discussion of "testing analysis and two analytical sources" in (a) and (b).

Art Unit: 3629

In claim 10, it's not clear the relationship of the "analysis data" in elements (a) and (b)? Are they the same or different? Element (d) is vague and indefinite. In step (e), It's not clear what results are being displayed?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 12-15 (apparatus), 1 (method) are rejected under 35 U.S.C. 102(a) as being anticipated by MARGREY et al (US patent 6,192,320).**

As for independent apparatus claim 12, MARGREY et al discloses a system for managing the data of a business using laboratory testing analysis, where the analysis is done by at least two analytical sources, comprising:

- a) at least a 1st means for storing analytical data at a 1st remote storage unit,
- b) at least a 2nd means for storing analytical data at a 2nd remote storage unit,

c) processor means for retrieving data from 1 of the plurality of analytical data storing means {see col. 4, lines 45-65 (or c4:45-65), c8:1-5, 45-65, c11:2-9}.

As for dep. claim 13-15 (part of 12), the further limitation on the details of the analysis (is done on petroleum-based products or oil) is considered as process limitations or manner or method in which a machine is to be operated and are considered as non-functional language and thus carrying non-patentable weight in an apparatus claim. Note that in apparatus claim, features of an apparatus in terms of structure rather than function is given patentable weight.

As for independent method claim 1, it's rejected for the same reason shown in claim 12 above and further in view of col. 8, lines 1-5, 45-65.

7. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over MARGREY et al as applied to claim 1 above, and further in view of Applicant Admitted Prior Art (AAPA) or BOYLE et al (US Patent 5,964,318).

As for dep. claim 2 (part of 1), MARGREY et al as cited above, fairly teaches interactive remote analyzing instrument and a central monitoring station for industrial application, i.e. hospital laboratories across the countries, using global information network for communication to provide better/more accurate analysis and more effective computer network communication (global computer network) (see c1:45-67, c2:1-5, c4:45-65, c6:1-10, 45-67, c7:1-15, c8:45-65, c11:2-9}. AAPA, as shown on page 2, discuss oil analysis service program with limited lab analysis and limited communication. BOYLE et al is also cited to show oil analysis service program with limited communication (see c1:1-20, c2:10-50, c4:1-15, c5:1-30). It would have been

obvious to modify the lab analysis and limited communication of AAPA or BOYLE et al with those of MARGREY et al for the benefits of improving lab analysis and more efficient computer network communication such as LAN, WAN, Internet, Intranet, etc, as taught by MARGREY et al. As for the difference in the type of lab sample, engine oil sample vs. medical lab sample such as blood, the difference is immaterial since the critical issue is the method of analyzing and communication and the method can be applied to various types of samples. Note that AAPA on page 2, 1st paragraph, also links to similar testing as in blood test. Therefore, it would have been obvious to apply the product analysis management system of MARGREY et al to other similar/equivalent industrial product such as petroleum-based such as oil or lubricant product as mere applying to other similar product to achieve similar results, absent evidence of unexpected results.

As for dep. claim 3 (part of 1), these are taught in AAPA pages 2-3 and BOYLE et al c4:5-15.

As for dep. claim 4 (part of 1), this is taught in MARGREY et al c6:1-10.

As for dep. claim 5 (part of 1), this is shown in BOYLE et al as diesel engine as in c1:5-10, c3:5-10.

As for dep. claim 6 (part of 1), this is taught in MARGREY et al c4:45-60, c8:1-60, Fig. 1.

8. Claims 7-9 (method), 10-11 (apparatus) are rejected under 35 U.S.C. 103(a) as being unpatentable over MARGREY et al in view of Applicant Admitted Prior Art (AAPA) or BOYLE et al (US Patent 5,964,318).

As for independent method claim 7, with step (e) being carried out using (iv.) reporting laboratory analysis results, it has similar limitations as in claims 2, 4 and 6, and therefore it's rejected for the same reasons set forth in the combination of rejections of claims 2, 4 and 6 above.

As for dep. claim 8 (part of 7), the limitation of (a) is fairly taught in MARGREY et al col. 6, line 50 to col. 7, line 20, and limitation of (b) is shown under "Analysis station" in c7:24 to c8:44.

As for dep. claim 9 (part of 7), this is fairly taught in MARGREY et al col. 6, lines 1-5, col. 7, line 5 to col. 8, line 65.

As for Independent Apparatus claim 10, which has similar limitations as in method claim 7, it is rejected for the same reason set forth in Independent claim 7 above. Note that the term "capable of" carries little patentable weight because this merely indicates the "ability to do something" and not positively claimed, i.e. performing a logic-and algorithmic-based analysis of a database. The IT system of MARGREY et al is capable of carrying out this limitation.

As for dep. claim 11 (part of 10), the limitation of retrieving data via Internet is taught in MARGREY et al col. 6, lines 1-10.

No claims are allowed.

Art Unit: 3629

9. Applicant is requested to resend a copy of the "E-commerce Oil Analysis" by the same inventor since it was not in the IDS submitted on the next office action.

10. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113

Or <http://pair-direct@uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn



DEAN T. NGUYEN
PRIMARY EXAMINER